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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,965	03/22/2004	Alain Rambach	15675P368D	2331
8791 7590 03/05/2007 BLAKELY SOKOLOFF TAYLOR & ZAFMAN 12400 WILSHIRE BOULEVARD SEVENTH FLOOR LOS ANGELES, CA 90025-1030			EXAMINER MARX, IRENE	
			ART UNIT 1651	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/05/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/806,965	<b>Applicant(s)</b> RAMBACH ET AL.	
	<b>Examiner</b> Irene Marx	<b>Art Unit</b> 1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed, after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 8-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

The amendment filed 1/24/07 is acknowledged.

Claims 7 and 12 are being considered on the merits.

Claims 1-6 and 8-11 are withdrawn from consideration as directed to a non-elected invention. It is noted that the non-elected invention of Group II is drawn to a use of an oxidizing metal complex for catalyzing oxidative polymerization of indoxyl derivatives which includes claims 9-11 as now amended. The claims of the elected invention are directed to a process of detecting bacteria. This is not the invention of claims 9-11 as now amended, which are clearly directed to a method of catalyzing an oxidative polymerization and which do not require detection of bacteria. The claim status identifiers should be changed accordingly.

To clarify the invention the terminology "X-Phos, X-acglmn, Mag-Gal, Mag- $\alpha$ -Gal, and Mag-Phos" should be properly explained. X-gal is defined at page 3, lines 7-8.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7 and 12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

No basis or support is found in the present specification for the recitation "indoxyl chemical derivative". While certain derivatives are taught, the basis for "indoxyl chemical derivative" is not clearly present in the as-filed specification.

No basis or support is found in the present written disclosed for the recitation "deleting the formation of a colored halo around the bacteria". It is noted that even if "detected" is intended, individual bacteria are not detectable without a microscope.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is lack of agreement between the "detection" requirement in the preamble and the body of the claim. Step c) is now directed to "deleting the formation of a colored halo around the bacteria". Is "detecting" intended? There is no clear indication that solid medium is used to "detect" colored halos or that single bacteria can be detected in this manner.

Claim 7 is confusing in the use of the terms "allows the oxidative polymerization" or "allowing the oxidative polymerization", since these are not positive process steps. The reaction either takes place or not.

Claim 12 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 12 does or does not further limit claim 7, since in the absence of an enzyme that causes release of the indoxyl derivative, no detectable reaction occurs.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman *et al.* (Molecular Microbiology (1999), vol. 33, No. 1, pages 18-32) taken with Dartois *et al.* (Journal of Bacteriology, Apr. 1998, Vol. 180, No. 7, p. 1855-1861) and Chevalier *et al.*

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The claims appear to be directed to a method for the detection of bacteria, wherein the bacteria are cultured anaerobically in a medium comprising ammoniacal iron citrate or ferricyanide and a substrate containing an indoxyl derivative such as X-gal..

Newman *et al.* disclose a method of detection of bacteria wherein the bacteria are grown on solid media comprising iron citrate and X-gal and wherein the bacterial colonies are detected by colored halos. See, e.g., Figure 3. The reference does not specifically indicate that the iron citrate product used is ammoniacal iron citrate. However, this product is recognized in the art to be useful in microbiology in conjunction with X-gal for screening and detection processes as shown by Dartois *et al.*. See, e.g., page 1856, paragraph 2. One of ordinary skill in the art would reasonably have expected polymerization to occur in the processes of Newman *et al.* and Dartois *et al.* in view of the presence of reactants comprising an oxidizing metal complex and at least one substrate containing an indoxyl derivative, in the absence of evidence to the contrary.

The references differ from the invention as claimed in that anaerobicity is not specifically disclosed. However, Chevalier *et al.* disclose a method of detecting bacteria grown anaerobically (page 77, last two lines) using X-gal as the substrate in a similar environment.

Accordingly, one of ordinary skill in the art would have had a reasonable expectation of success in detecting anaerobic bacteria by modifying the process of Newman *et al.* by using ferric ammonium citrate (ammoniacal iron citrate) as suggested by the teachings of Dartois *et al.* using anaerobicity as taught by Chevalier *et al.* for the expected benefit of detecting anaerobic bacteria, and anaerobic pathogens in particular, more effectively and efficiently.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to modify the detecting process of bacteria when using ferric citrate in conjunction with X-gal as taught by Newman *et al.* by using ferric ammonium citrate (ammoniacal iron citrate) in conjunction with X-gal as suggested by the teachings of Dartois *et al.* and using anaerobicity as taught by Chevalier *et al.* in a process of detecting anaerobic bacteria for the expected benefit of detecting and differentiating a greater variety of pathogenic and deleterious bacteria in food and water, for example, with a more sensitive and effective detection test.

Thus, the claimed invention as a whole was clearly *prima facie* obvious, especially in the absence of evidence to the contrary.

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Applicants' arguments are moot in view of the new grounds of rejection.

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (571) 272-0919. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Irene Marx

Primary Examiner

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